

## **REMARKS**

Applicant respectfully requests reconsideration of this application, as amended, and consideration of the following remarks.

### **Unreturned 1449 Form**

Applicant notes that an IDS form 1449 submitted on July 19, 1999 has not yet returned by the Examiner. Applicant respectfully requests the Examiner mark the references as considered and return a copy of the marked 1449 to Applicant with the next communication.

### **Amendments**

#### ***Amendments to the Claims***

Applicant has amended claims 11, 21 and 36 to more particularly point out that the viewer is asked if the viewer is interested in viewing the broadcast of an upcoming program during an advertisement for the program. Claims 23-27, 31-32, and 49-51 have been amended to depend from claim 21. No new matter has been added as a result of these amendments.

### **Rejections**

#### ***Rejections under 35 U.S.C. § 103***

#### **Claims 1-7, 9, 10, 19-20, 23-34, 38, 40-42, 50-52 and 54-56**

Claims 1-7, 9, 10, 19-20, 23-34, 38, 40-42, 50-52 and 54-56 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,699,107 to Lawler in view of U.S. Patent 5,990,027 to Hendricks. As a result of this preliminary amendment, claims 1-7, 9, 10, 19-20, 33, 34, 38, 40-42 and 54-56 are cancelled, and claims 23-32 and 50-52 now depend from claim 21. Therefore, the rejection of claims 1-7, 9, 10, 19-20, 23-34, 38, 40-42, 50-52 and 54-56 under 35 U.S.C. § 103(a) over the combination of Lawler and Hendricks is moot.

#### **Claims 8, 11-18, 21, 22, 35-37, 39, 43-48, 53 and 57-60**

Claims 8, 11-18, 21, 22, 35-37, 39, 43-48, 53 and 57-60 stand rejected under 35 U.S.C. § 103(a) as being obvious over Lawler in view of Hendricks and U.S. Patent

5,583,560 to Florin. Claims 8, 35, 39 and 53 have been cancelled. Because claims 23-32 and 50-52 now depend from claim 21, the patentability of claims 23-32 and 50-52 is argued in conjunction with claim 21.

As discussed in the Amendment After Final filed on January 6, 2003, Lawler discloses a television program reminder for an interactive cable television system that allows a viewer to select a specific program from a program guide. A corresponding tag stored at the headend and is used to display a reminder to the user shortly before the program is to be broadcast. The Examiner admits that Lawler does not disclose storing program recording information local to the user as claimed by Applicant and relies on Hendricks to teach this missing element. As motivation for the combination, the Examiner states:

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler to store the reminder information locally as taught by Hendricks thereby allowing a user to view a reminder and watch a program *even if the network connection between the STB and the headend is severed*. [emphasis added]

In the Amendment After Final, Applicant argued that the combination was improperly motivated because it is well known in the art that a connection between the STB (set top box) and the headend is required to watch or record a broadcast program in the television delivery systems taught by Lawler and Hendricks. In the Advisory Action mailed on February 11, 2003, the Examiner cited column 42, lines 31-50 of Hendricks as teaching that the broadcast program could be received by the STB from a satellite if the headend connection to the STB is severed.

Applicant respectfully disagrees with the Examiner on this interpretation of Hendricks. In a satellite system as taught by Hendricks, the satellite transfers broadcast signals and program information received from a satellite operations center to the subscribers' STBs. Hendricks specifically states that the satellite embodiment is used when cable services are unavailable. Headends are typically used in cable systems to transfer broadcast signals and program information received from a cable operations center to a group of subscribers' STBs. Thus, the satellite serves as the same purpose as a cable headend in Hendricks' satellite embodiment. If the connection between the satellite and the STB is severed, the user will be unable to watch a broadcast program. Therefore,

the Examiner's stated motivation for the combination is not supported by either of the references or the art as a whole and, in fact, runs counter to the accepted teachings of the art.

Because the combination of Lawler and Hendricks is improperly motivated, the combination cannot form the basis for a proper *prima facie* case of obviousness and thus the combination of Lawler, Hendricks and Florin is also improper. Furthermore, Applicant respectfully submits that the combination of Lawler, Hendricks and Florin cannot render Applicant's invention obvious because the combination does not teach each and every element of the invention as claimed in claims 11-18, 21-32, 36-37, 45-52 and 57-60.

Florin discloses a system that displays an icon on broadcast advertisements that, when activated, shows the viewer information about the advertised products. As amended, Applicant's claimed invention includes the element of issuing a notification to a viewer during an advertisement for an upcoming program to determine if the viewer is interested in viewing the broadcast of the program. Applicant further claims that the viewer's response to this notification generates a signal that causes the program reminder to be shown to the viewer. There is no teaching or suggestion in Florin that the user is asked about his/her interest in viewing the broadcast of an advertised program. Furthermore, no teaching in Lawler, Hendricks or Florin suggests that activating Florin's icon generates a signal that causes a program reminder for the broadcast program to be shown to the user.

Therefore, the combination of Lawler, Hendricks and Florin is improperly motivated and does not teach each and every element of Applicant's invention as claimed in pending claims 11-18, 21-32, 36-37, 43-52 and 57-60 and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(b) over the combination.

### **SUMMARY**

As a result of this preliminary amendment, claims 11-18, 21-32, 36-37, 43-52 and 57-60 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance.

Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-3476.

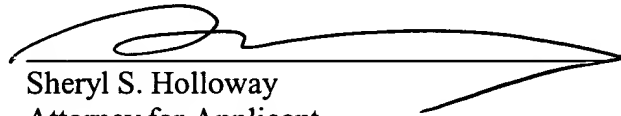
**Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR  
& ZAFMAN LLP

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